

REMARKS

Upon entry of the foregoing Amendment, claims 1-61 are pending in the application. Claims 1, 6, 11, and 14 are amended and claims 17-61 are added. In view of these amendments and following remarks, reconsideration and allowance of all the claims pending in the application are respectfully requested.

Telephone Interview

Applicants thank Examiner Bieneman for courtesies extended to Applicants' representatives during a telephonic interview on June 11, 2003.

Rejection Under 35 U.S.C. § 102

Claims 1-2, 6-7, 11 and 14 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,987,480 to Donohue et al ("Donohue"). Applicants traverse this rejection. In an attempt to clarify the invention, however, Applicants have amended claim 1. Claim 1, as amended, includes, *inter alia*, the features of "the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document" and "a document insertion module that inserts the insert document into the main document." At least these features are not disclosed, taught or suggested by Donohue.

The Examiner states that Donohue discloses a data storage mechanism that stores the main document with a formula that resolves to a reference to an insert document (See page 3 of the Office Action). Apparently, the Examiner relies on col. 6, lines 10-13, col. 7, lines 37-41, and col. 10, lines 60-65 of Donohue. Applicants respectfully submit that these cited portions of Donohue disclose inserting stored textual contents such as name, user-ID, order-ID, total-due, etc., into a web-based template using dynamic HTML content tags. Inserting textual data is not the same as inserting a document that includes the data. Thus, Donohue does not disclose, teach or suggest inserting the insert document into the main document as set forth in claim 1. For at least this reason, Applicants respectfully submit that claim 1 is patentable over Donohue. Independent claims 6, 11, and 14 have been amended to include a feature similar to that recited in claim 1.

Applicants respectfully submit that independent claims 6, 11, and 14 are patentable for at least the reasons set forth above for claim 1.

Dependent claims 2 and 7 depend from and add additional features to independent claims 1 and 6 respectively. Because Donohue does not disclose, teach or suggest each of the features recited in the independent claims, Applicants respectfully submit that dependent claims 2 and 7 are also patentable for at least the foregoing reasons.

Rejection Under 35 U.S.C. § 103(a)

Dependent claims 3, 8, 12 and 15 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of U.S. Patent No. 6,226,648 to Appleman et al ("Appleman"). Dependent claims 3, 8, 12 and 15 each depend from and add additional features to one of independent claims 1, 6, 11, and 14. As discussed above Donohue does not disclose, teach or suggest each of the features recited in the independent claims. Appleman does not provide any teaching or suggestion to make up for the deficiencies of Donohue. Therefore, Applicants respectfully submit that dependent claims are 3, 8, 12 and 15 also patentable over Donohue in view of Appleman for at least the foregoing reasons.

Dependent claims 4, 9 and 13 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of Appleman and further in view of U.S. Patent 6,006,242 to Poole et al ("Poole"). Dependent claims 4, 9 and 13 each depend from and add additional features to one of independent claims 1, 6, 11, and 14. As discussed above Donohue does not disclose, teach or suggest each of the features recited in the independent claims. Appleman or Poole, alone or in combination with one another, do not provide any teaching or suggestion to make up for the deficiencies of Donohue. Therefore, Applicants respectfully submit that dependent claims 4, 9 and 13 are also patentable over Donohue in view of Appleman and further in view of Poole for at least the foregoing reasons.

Dependent claims 5 and 10 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of World Wide Web Consortium, *HTML 3.2 Reference Specification*, W3C Recommendation, 14 January 1997, page 107 ("W3C") and further in view of Appleman. Dependent claims 5 and 10 each depend

from and add additional features to one of independent claims 1, 6, 11, and 14. As discussed above Donohue does not disclose, teach or suggest each of the features recited in the independent claims. W3C or Appleman, alone or in combination with one another, do not provide any teaching or suggestion to make up for the deficiencies of Donohue. Therefore, Applicants respectfully submit that dependent claims 5 and 10 are also patentable over Donohue in view of W3C and further in view of Appleman for at least the foregoing reasons.

New Claim 61

Claim 61 includes, *inter alia*, the feature of “inserting said identified insert document into said main document at a pre-determined document location point.” At least this feature is not disclosed, taught or suggested by Donohue or any of the other references relied upon by the Examiner, alone or in combination with one another.

Applicants respectfully submit that Donohue discloses inserting stored textual contents such as name, user-ID, order-ID, total-due, etc., into a web-based template using dynamic HTML content tags. Inserting textual data is not the same as inserting a document that includes the data. Therefore, Donohue does not disclose, teach or suggest inserting the insert document into the main document as set forth in claim 61.

In addition, claim 61 includes, *inter alia*, the feature of “resolving the formula continuously in order to modify said identified insert document that is inserted in the main document.” At least this feature is not disclosed, taught or suggested by Donohue or any of the other references relied upon by the Examiner, alone or in combination with one another.

For the sake of argument, even if the textual data in Donohue is considered equivalent to an insert document, Donohue does not modify the inserted textual data based on continuously resolving a formula. Thus, Donohue does not disclose, teach or suggest continuously resolving the formula in order to modify the insert document that is inserted in the main document as set forth in claim 61.

Each of the other references relied upon by the Examiner, alone or in combination with one another, do not provide any teaching or suggestion to make up for the

deficiencies of Donohue. For at least the foregoing reasons, Applicants respectfully submit that claim 61 is patentable over the references relied upon by the Examiner.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance and such disposition is earnestly solicited. If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the convenience of the Examiner.

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Respectfully submitted,



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